

Notice of Allowability

Application No.

09/659,821

Examiner

Taylor Victor Oh

Applicant(s)

IKUSHIMA ET AL

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/22/2004.
2. ☒ The allowed claim(s) is/are 1-22.
3. ☒ The drawings filed on 11 September 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No./Mail Date <u>4/8/04</u> |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>9/11/2000</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Examiner's Amendment and Reasons of Allowance

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Corwin Umbach on 4/8/2004 .

I. The application has been amended as follows:

In claims 1 and 2, lines 3-4 on page 2 (amendment on 1/22/2004):

The phrase"--in the absence of catalyst without addition of any basic catalyst--" has been added after the word "reaction" and before the word "in" .

In claims 3 and 4, lines 2-3 on page 2 (amendment on 1/22/2004):

The phrase"--in the absence of catalyst without addition of any basic catalyst--" has been added after the word "reaction" and before the word "in" .

In claims 5 and 6, lines 2-3 on page 2 (amendment on 1/22/2004):

The phrase"--in the absence of catalyst without addition of any basic catalyst--" has been added after the word "aldehyde" and before the word "near" .

II. The following is an examiner's statement of reasons for allowance:

- The rejection of claims 3-6 under 35 U.S.C. 112, first paragraph, has been withdrawn due to applicants' convincing argument made in the amendment.
- The close reference for the current invention is An et al (Applications of High-Temperature Aqueous Media for synthetic Organic Rxns, J. Org. Chem. 1997, 62, 2505-2511).

An et al discloses applications of high-temperature aqueous media for synthetic organic reactions such as a Cannizzaro reaction in which benzaldehyde has generated benzoic acid and benzyl alcohol. The reference has indicated that the reaction conditions are near a temperature of 290 °C and at the pressure of 50 atmospheres at a reaction time of 60 mins.

However, the instant invention differs from the reference in that the Cannizzaro reaction is performed at least 350 °C. with a reaction time of 10-400 seconds, using a supply of OH from water in the pressure range from 22.5 to 25 Mpa in the absence of any basic catalyst. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*May 15
4/12/04*

BA K. TRINH

**BA K. TRINH
PRIMARY EXAMINER
GROUP 1200-1625**